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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,240	03/23/2004	Giovanni Caponetti	250893US0CONT	1764
22850 7590 04/05/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER ALSTRUM ACEVEDO, JAMES HENRY	
			ART UNIT	PAPER NUMBER
			1616	

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	04/05/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 04/05/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Office Action Summary**

Application No.

10/806,240

Applicant(s)

CAPONETTI ET AL.

Examiner

James H. Alstrum-Acevedo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22-29 and 31-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-29 and 31-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

**Claims 22-29 and 31-33 are pending.** Applicants previously cancelled claims 1-21. Applicants have newly cancelled claim 30. Applicants have amended claims 22 and 27. Receipt and consideration of Applicants' amended claim set and remarks/arguments submitted on January 16, 2007 are acknowledged. Applicants claim amendments necessitated a new rejection under 35 U.S.C. § 103(a) of claims 22-29 and 31-33. Claims 22-26 and 32 had been previously rejected under 35 U.S.C. 102(b) as being anticipated by Ganderton et al. (U.S. Patent No. 5,376,386).

### ***Moot Rejections/objections***

All rejections and/or objections of claim 30 cited in the previous office action mailed on October 16, 2006 **are moot**, because said claim has been cancelled.

### ***Specification***

The objection to the specification for the improper use of the trademarks PULVINAL<sup>®</sup> (pg. 22, line 25; pg. 23, line 10; and pg. 26, line 19) and TURBULA<sup>®</sup> (pg. 22, lines 11 and 18; Example 5 on pg. 29) as set forth on page 2 of the office action mailed on October 16, 2006 **is withdrawn** per Applicants' amendments correctly capitalizing the cited trademarks at every occurrence in the specification.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

The rejection of claims 26-27 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn per Applicants' amendments removing indefinite language.

### *Response to Arguments*

Applicant's arguments, see page 8, filed January 16, 2007, with respect to the rejection of claims 26-27 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention have been fully considered and are persuasive. The rejection of claims 26-27 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn.

### *Claim Rejections - 35 USC § 102*

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The rejection of claims 22-26 and 32 under 35 U.S.C. 102(b) as being anticipated by Ganderton et al. (U.S. Patent No. 5,376,386) is withdrawn per Applicants' amendments requiring that the claimed process utilize a high-speed granulator and wherein the solvent is a short-chain aliphatic alcohol or a water and alcohol mixture.

***Response to Arguments***

Applicant's arguments, see page 7, filed January 16, 2007, with respect to the rejection of claims 22-26 and 32 under 35 U.S.C. 102(b) as being anticipated by Ganderton et al. (U.S. Patent No. 5,376,386) have been fully considered and are persuasive. The rejection of claims 22-26 and 32 under 35 U.S.C. 102(b) as being anticipated by Ganderton et al. (U.S. Patent No. 5,376,386) has been withdrawn.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Applicant Claims
2. Determining the scope and contents of the prior art.
3. Ascertaining the differences between the prior art and the claims at issue; and resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

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evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The rejection of claims 27-29, 31, and 33 under 35 U.S.C. 103(a) as being unpatentable over Ganderton et al. (U.S. Patent No. 5,376,386) in view of Kato et al. (EP 0786526; IDS) **is maintained** for the reasons of record set forth on pages 3-8 of the office action mailed on October 16, 2006. In addition, claims 22-26 and 32 are appended to this rejection for the reasons of record. In summary, **claims 22-29 and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ganderton et al. (U.S. Patent No. 5,376,386) in view of Kato et al. (EP 0786526; IDS).**

### *Response to Arguments*

Applicant's arguments filed January 16, 2007 have been fully considered but they are not persuasive. Applicants' traversal arguments are based on their assertions that (1) the term "granules" does not read on individual particles (i.e. unagglomerated particles), thus rendering the combination of Ganderton and Kato improper and (2) that even if one of ordinary skill in the art would have been motivated to combine the cited references said ordinary skilled artisan would not have been able to obtain the claimed invention absent an undue burden. The Examiner respectfully disagrees with Applicants' traversal arguments. Argument (1) is unpersuasive because the term granule reads on a single grain of powder; therefore, granulating is a process of making powders, which inherently comprise individual particles. Applicants have

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provided no additional evidence to support their assertion. Absent data mere argument is unpersuasive. Applicants' second traversal is unpersuasive, because it represents mere argument. Thus, the Examiner concludes that the instant rejection remains proper. Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because the combined teachings of the prior art is fairly suggestive of the claimed invention.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The rejection on the ground of nonstatutory obviousness-type double patenting of claims 22-29 and 32-33 as being unpatentable over claims 1-12 of U.S. Patent No. 6,780,508 (USPN

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'508) **is maintained** for the reasons of record set forth on pages 8-9 of the office action mailed on October 16, 2006.

### ***Response to Arguments***

Applicant's arguments filed January 16, 2007 have been fully considered but they are not persuasive. Applicants' traversal of the instant rejection is based upon their observation that incorporation of the limitation of claim 30, which required the use of a solvent comprising a short-chain aliphatic alcohol or a water alcohol mixture and was not included in the rejection, would obviate the instant rejection. This is not found persuasive, because when one looks to the disclosure of USPN '508 (e.g. col. 7, lines 28-41) to understand what was meant by for the step of "repeated wetting and drying" it is clear that this step is performed using short-chain alcohols or a water alcohol mixture. Therefore, the inclusion of the limitation of claim 30 into claim 22 is an obvious modification and the instant rejection remains proper.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following references are considered relevant because these disclose methods of making powders having rugosities similar to those made by the methods claimed in the instant application: (1) U.S. Patent No. 5,603,960 (O'Hagan et al.) and (2) U.S. Patent No. 6,051,256 (Platz et al.).



**Claims 22-29 and 31-33 are rejected. No claims are allowed.**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Alstrum-Acevedo whose telephone number is (571) 272-5548. The examiner can normally be reached on M-F, 9:00-6:30, with every other Friday off.

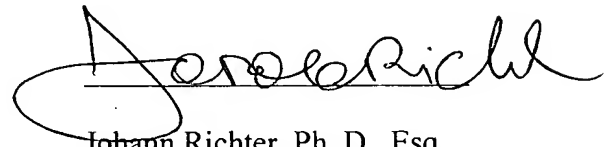
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571) 272-0664. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James H. Alstrum-Acevedo, Ph.D.  
Patent Examiner  
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A handwritten signature in black ink, appearing to read 'Johann Richter', written over a horizontal line.

Johann Richter, Ph. D., Esq.  
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